UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Faint

Mailed: October 26, 2012

Opposition No. 91204622

Volume 12 LLC

v.

American Essentials Inc.

By the Trademark Trial and Appeal Board:

This case now comes up on applicant's motion to dismiss,[1] filed pursuant to Fed. R. Civ. P. 12(b)(6), alleging opposer's lack of standing as a "threshold" issue. The motion is contested.[2]

Background

By way of background, an application has been filed by American Essentials, Inc. to register the mark V12 in standard character form for, "clothing, namely, legwear, namely,

[1] Applicant filed two versions of the motion to dismiss on the same day. It appears that the second version of the motion, designated as docket number 5, includes attachments that were not part of the previous version.

[2] It is noted that both applicant and opposer have submitted matters outside the pleadings with the motion to dismiss, and response, respectively. However, under the rules, a motion for summary judgment may not be filed until after the parties have made their initial disclosures. Trademark Rule 2.127(e). There is no indication that initial disclosures have been made. Accordingly, the matters applicant submitted in support of its motion to dismiss, and that opposer submitted in response, are excluded from consideration.

hosiery, socks, leggings, tights, pantyhose, stockings, gaiters and trouser socks; loungewear and sleepwear, namely, robes, caftans and kimonos; underwear, lingerie; pants, jeans, shorts; shirts, namely, dress shirts, T-shirts, polo shirts, turtlenecks, casual shirts, sweat shirts, knit shirts, blouses, tops; sweaters, cardigans; dresses, skirts, body stockings; suits, jackets, sport jackets, vests; neckwear, namely, ties, scarves, bow ties, neck warmers and shirt inserts, namely, dickies; cummerbunds; formal wear, namely, tuxedos, gowns, wedding gowns; activewear and fleecewear, namely, sweat shirts, sweat pants, sweat suits, track suits; exercise clothing, namely, tights, shorts, tops, headbands, body suits, leotards, wrist bands; fur coats and stoles; jackets and vests; coats and top coats; ski wear; rainwear, namely, raincoats; headwear, namely, caps, hats, toques, knitted hats, headbands, ear muffs, balaclavas, bandannas, baseball caps and visors; mufflers, scarves; mittens, gloves; footwear, namely, shoes, slippers, boots; swimwear; beachwear, namely, robes, hats, sun visors, cover-ups, sarongs" in Class 25.[3]

Volume 12 LLC has opposed the application claiming ownership of Registration Nos. 3975548, 3990655, 4013998 and 4013999, and other pending applications. Copies of the registrations were not submitted with the notice of opposition.

In lieu of an answer to the notice of opposition, on May 17, 2012, applicant filed a motion to dismiss the proceeding under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief may be granted. As grounds for the motion to dismiss, applicant states that opposer's claims as to ownership of the cited registrations and pending applications are for marks filed and owned by an individual, Kenneth [sic] J. Brunelle, and not opposer.[4] Opposer, appearing pro se through Ken J. Brunelle, responded contending that Ken J. Brunelle is the founder and majority owner of Volume 12 LLC. Opposer also "wishes to clarify certain claims" presented in the motion to dismiss, and provides five numbered paragraphs of information essentially alleging Mr. Brunelle is the owner of Volume 12, LLC, as well as the underlying trademark registrations and applications asserted in the notice of opposition.

Motion to Dismiss

To survive a motion to dismiss a plaintiff need only allege sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, a complaint "must contain sufficient factual matter, accepted as true, to

[3] Application Serial No. 85227309, filed Jan. 27, 2011, based on intent to use the mark in commerce pursuant to Trademark Act § 1(b).

'state a claim to relief that is plausible on its face.'" *Doyle v. Al Johnson's Swedish Restaurant & Butik, Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012) *quoting Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). In the context of inter partes proceedings before the Board, a claim has facial plausibility when the plaintiff pleads factual content that allows the Board to draw a reasonable inference that the plaintiff has standing and that a valid ground for the opposition exists. *Cf. Bell Atlantic Corp. v. Twombly,* 550 U.S. 544, 556 (2007). Apart from specifying that sufficient factual matter be "well-pleaded" and, when so pleaded be accepted as true, the Court also explains that "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice" and are not accepted as true. *Iqbal* 556 U.S. at 678 (citing *Twombly*, 550 U.S. at 555).

At the pleading stage, all that is required is that a plaintiff allege facts sufficient to show a "real interest" in the proceeding, and a "reasonable basis" for its belief that it would suffer some kind of damage if the mark is registered. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). Standing is a distinct issue from the merits of the case. *Jewelers Vigilance Committee, Inc. v. Ullenberg*

[4] Opposer also claims ownership of a domain name, and applicant asserts that public records show ownership of the domain name by a different individual.

Corp., 823 F.2d 490, 493, 2 U.S.P.Q.2d 2021, 2024 (Fed. Cir. 1987).

Applicant alleges that opposer is without standing to bring its notice of opposition pursuant to Trademark Act § 2(d) because opposer does not own the marks referenced in the complaint. Opposer, however, claims in the notice of opposition:

> 5. Opposer has been vigorously building the "Volume 12 Brand" since early 2009 in the field of professional sports.
> 14. Since early 2010, opposer has continuously used "V12" as an abbreviated or shortened version of Volume 12 in connection with the general public.

The Board construes these as allegations that opposer, as Volume 12, LLC, is an authorized user of the marks in commerce, and this is sufficient for notice pleading in a likelihood of confusion case.[5] Opposer should be aware, however, that it may not plead, or rely on, registrations where it is not the owner of the mark, nor rely on those registrations for purposes of priority, as the presumptions afforded by Trademark Act § 7(b) do not inure to opposer. *Hunt Control Systems, Inc. v.*

[5] For instance, a plaintiff whose use of a pleaded mark is as a licensee of the trademark owner may have standing in a case brought under Section 2(d) of the Trademark Act even where it does not claim ownership of the allegedly similar mark, or the right to control its use. *See, e.g., J.L. Prescott Co. v. Blue Cross Labs.*, 216 USPQ 1127 (TTAB 1982) (opposer that had assigned mark and obtained exclusive license from assignee held to have standing); *see also In re Briggs*, 229 USPQ 76, (TTAB 1986) (applicant individual was owner of mark and use pursuant to oral license by corporation which he directed inured to applicant's benefit).

Koninklijke Philips Electronics, N.V., 98 USPQ2d 1558, 1563 (TTAB 2011). Proof of opposer's standing is left to trial. *Ritchie* at 1029.

With regard to the ground for opposition, opposer has alleged priority and likelihood of confusion. The burden will be on opposer to prove that it has proprietary rights in a trademark, and that applicant's mark is likely to cause confusion with that trademark. *Life Zone Inc. v. Middleman Group, Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008).

However, the Board construes opposer's response as also comprising a motion for leave to file an amended notice of opposition.

In view thereof, applicant's motion to dismiss is **denied**, inasmuch as opposer has sufficiently alleged standing to survive a motion to dismiss. Opposer's motion to file an amended notice of opposition is **granted**, to the extent that applicant may amend its pleading in line with this order.

NATURE OF BOARD PROCEEDINGS

Opposer is advised that an *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a

trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.

REQUIREMENT FOR SERVICE OF PAPERS

The service requirements are set forth in Trademark Rule 2.119. Trademark Rules 2.119(a) and (b) and require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board.

Consequently, copies of all papers which either party may subsequently file in this proceeding, including applicant's answer to the notice of opposition, must be accompanied by a signed statement indicating the date and manner in which such service was made. Strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.

The Board will accept, as *prima facie* proof that a party filing a paper in a Board *inter partes* proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. This written statement should take the form of a "certificate of service" which should read as follows:

> The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon opposer by forwarding said copy, via first class mail, postage prepaid to: [insert name and address].

The certificate of service must be signed and dated. *See also* TBMP §113 (2d ed. rev. 2004).

OPTION OF E-MAIL SERVICE

The parties may agree to the email service option now available under Trademark Rule 2.119(b)(6) ("Electronic transmission when mutually agreed upon by the parties.").[6] Should the parties decide to continue using traditional service options, the parties may consider agreeing at least to courtesy email notification when any paper is served.

[6] The additional five days available under Trademark Rule 2.119(c) for traditional service modes (*e.g.*, First Class Mail) is not available for email service.

THE BOARD'S STANDARDIZED PROTECTIVE ORDER IS IN PLACE

The Board's standard protective order is in place in this case governing the exchange of confidential and proprietary information and materials. The parties may substitute a stipulated protective agreement (signed by both parties). However, the Board will not become involved in a dispute over any substitution in view of the existence of the Board's standardized protective order.

REPRESENTATION

The Board notes opposer is representing itself pro se, through its president. Opposer may do so. However, it should also be noted that while Patent and Trademark Rule 11.14 permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board may not provide legal advice, though may provide information as to procedure.

ELECTRONIC RESOURCES

All parties may refer to the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, both available on the USPTO website, *www.uspto.gov*.

The TTAB homepage provides electronic access to the Board's standardized protective order, the rules and answers to frequently asked questions. Other useful databases include the ESTTA filing system[7] for Board filings and TTABVUE for status and prosecution history.

The Board's records are public records. Thus, opposer may use the TTABVUE database to view other cases to get an idea of the course of Board proceedings.

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.

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[7] Use of electronic filing with ESTTA, available through the USPTO website, is strongly encouraged. This electronic file system operates in real time. The filing party is also provided with a confirmation number that the filing has been received.

A party may also use first class mail. Correspondence required to be filed in the Office within a set period of time will be considered as being timely filed on the date of deposit in the mail if accompanied by a certificate of mailing.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

The certificate of mailing must be signed and dated. The actual date of receipt by the Office will be used for all other purposes, including electronically filed documents.
The certificate of mailing must be signed and dated.

Dates Reset

Proceedings are resumed. Dates are reset as set out below.

Time to File Amended Notice of Opposition	**11/19/2012**
Time to Answer	**12/19/2012**
Deadline for Discovery Conference	**1/18/2013**
Discovery Opens	**1/18/2013**
Initial Disclosures Due	**2/17/2013**
Expert Disclosures Due	**6/17/2013**
Discovery Closes	**7/17/2013**
Plaintiff's Pretrial Disclosures Due	**8/31/2013**
Plaintiff's 30-day Trial Period Ends	**10/15/2013**
Defendant's Pretrial Disclosures Due	**10/30/2013**
Defendant's 30-day Trial Period Ends	**12/14/2013**
Plaintiff's Rebuttal Disclosures Due	**12/29/2013**
Plaintiff's 15-day Rebuttal Period Ends	**1/28/2014**

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rules 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

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